REMARKS

Claims 1, 3-7, 9, and 12-29 are pending but stand rejected. Claim 18 and 26-28 have been withdrawn from further consideration as being directed to a non-elected species. Claims 1, 3, 4, 6, 7, 12, 13, 20, and 21 have been amended. Claims 2, 8, 10, 11, 30, and 31 have been cancelled. In view of the amendments and the following remarks, the Applicant respectfully requests the Examiner's thoughtful reconsideration.

OBJECTIONS TO THE SPECIFICATION: The Examiner objected to the specification asserting that the preliminary amendment filed along with the application recites material not supported by the original disclosure. Specifically, the preliminary amendment added a passage to the Specification that referred to a controller causing a scan module to print. The Specification has been amended to recite that the controller causes a print module to print. As such the amendment finds support in the specification as originally filed.

OBJECTIONS TO THE CLAIMS: The Examiner objected to Claim 8 noting a misprint. Claim 8 has been amended to address the Examiner's concerns.

CLAIM REJECTIONS – 35 USC §112: The Examiner rejected Claims 8, 14, 22, and 31 for failing to comply with the written description requirement of §112. Claim 8 has been cancelled. With respect to Claims 14, 22, and 31, the Examiner asserts that the Specification do not provide support for the limitation "the prompts for different standard photo sizes correspond to maximum printable area on a sheet." The Applicant kindly disagrees.

The Examiner's attention is drawn to page 4, line 19 through page 5, line 12 of the Specification as originally filed. That passage describes various prompts that relate to a number of standard sized images that are to be printed on a letter sized sheet. One prompt is for "9 wallets", another is for "4 3"x5"", another is for "2 5"x7"", and

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another is for "1 8"x10"". It is inherent that a standard letter sized sheet has a maximum printable area. Physical size limitation dictate that only 9 wallet sized images can fit within that area. The same is true for the specified numbers of the other various sizes. Consequently, Specification describes prompts for the various standard photo sizes where those prompts correspond to a maximum printable area on a sheet.

Therefore, the Examiner's rejection of Claim 14, 22, and 31 under §112 is improper.

CLAIM REJECTIONS – 35 USC §103: The Examiner rejected Claims 1-31 citing various combinations of the following references:

1. USPN 6,226,105 issued to Fukushi.

2. USPN 4,862,200 issued to Hicks.

3. USPN 5,889578 issued to Jamzadeh

4. USPN 5,748,344 issued to Rees

5. USPN 6,236,473 issued to Collard

Claims 1 and 6 remain as the only independent claims and are addressed in detail below. Claims , 8, 10, 11, 30, and 31 have been cancelled and are not addressed.

Claim 1, as amended, is directed to an apparatus for scanning an image and printing copies of the image on a sheet and recites the following:

1. a scan module;

2. a print module;

3. an input device for allowing a plurality of different a standard photo sizes to be selected; and

4. means for causing the scan module to scan the image from an original of any size, the means automatically determining an actual size of the

scanned image, scaling first copies of the scanned image to a first selected photo size, and scaling second copies of the scanned image to a second selected photo size, the means also causing the print module to print first copies of the scanned image on a first sheet and to print the second copies of the scanned image on a second sheet.

The Examiner rejected Claim 1 as being unpatentable over USPN 6,226,105 issued to Fukushi. Referring to Claim 2, now cancelled, the Examiner admitted that Fukushi fails to teach or suggest "wherein the means causes copies of a different photo size to be printed on an additional sheet when the Photo Package entry is selected." In this context, Claim 1 has been amended so that the recited means is for scaling copies to first and second photo sizes and for causing a print module to print copies of the first size on a first sheet and copies of the second size on a second sheet. As with Claim 2, these are limitations not taught by Fukushi.

Addressing Fukushi's deficiency with respect to Claim 2, the Examiner turned to USPN 4,862,200 issued to Hicks. Specifically, the Examiner cites Hicks, col. 6, lines 57-60; col. 10, lines 15-20; and col. 11, lines 25-28 and 35-43.

Hicks discloses a film based camera having an associated input device and memory. Hicks, Fig. 1A. Processing instructions for images taken using the camera are entered through the input device and saved in the memory. Hicks, col. 6, lines 10-60. The processing instructions for a particular image are stored in a memory location that is in some manner associated with that image. Hicks, Col. 7, lines 7-15.

Hicks, col. 6, lines 20-25 discloses that a package selection is a mixture of various photo sizes of a particular subject. Hicks, col. 6, lines 44-50 discloses that a user can press a code button for a particular package selection for a particular subject to ensure that the subject will receive, at the time the order is processed, photo prints indicate by the package selection. Hicks, col. 6, lines 57-60 discloses that the camera's shutter acts as a trigger to expose film and simultaneously transmit electronic data regarding the particular order (the package selection) to a memory module. Hicks, col.

10, lines 15-20 discloses that a photographic processing sequence once written to memory serves as a source for functions in a commercial photo finishing process. Hicks, col. 11, lines 25-28 discloses a photographic printer that exposes each negative on a roll according to instructions contained in the memory. Hicks, col. 11, lines 35-43 discloses that an exposed roll of prints is mounted to a print cutter that is guided by a microcontroller. Cutting instructions are obtained from the memory.

Hicks makes no mention of a means capable of generating second scanned image copies that are scaled to a second photo size and then causing a print module to print the second copies on a second sheet as recited by Claim 1. Hicks does not even disclose generating a scanned copy of an original image. Instead, Hicks discusses dark room methods for producing photo prints from negatives. Hicks, col. 10, line 16 through col. 11, line 13.

Consequently, the cited references fail to teach or suggest an apparatus that includes means for scaling first copies of the scanned image to a first selected photo size, scaling second copies of the scanned image to a second selected photo size, and causing the print module to print first copies of the scanned image on a first sheet and to print the second copies of the scanned image on a second sheet. For at least these reasons, Claim 1 is patentable over the cited references as are Claims 3-5 and 12-19 which depend from Claim 1.

As amended, Claim 6 is directed to an apparatus for scanning an image and printing copies of an image on a sheet and recites the following:

1.   a scan module;

2.   a print module;

3.   an input device for allowing a plurality of different [[a]] standard photo sizes to be selected; and

4.   a controller for causing the scan module to scan the image from an original of a plurality of sizes, the controller automatically determining

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actual size of the scanned image, generating first scanned image copies that are scaled to a first elected photo size and that are positioned to utilize maximum printable area on a first sheet, generating second scanned image copies that are scaled to second selected photo size and that are positioned to utilize maximum printable area on a second sheet, and causing the print module to print the first copies on the first sheet and to print the second copies of the scanned image on the second sheet.

The Examiner rejected Claim 6 under §103 citing Fukushi in view of USPN 5,889578 issued to Jamzadeh.

Not unlike Claim 1, Claim 6 recites a controller for generating first scanned image copies that are scaled to a first selected photo size, generating second scanned image copies that are scaled to second selected photo size, and causing the print module to print the first copies on the first sheet and to print the second copies of the scanned image on the second sheet. Claim 6 further recites that the controller acts to use the maximum printable area on the first and second sheets.
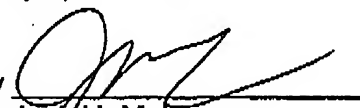
As with Claim 1, Fukushi and Hicks fails to teach or suggest such a controller. Jamzadeh is silent on the issue. Consequently, the cited references fail to teach or suggest an apparatus that includes a controller for generating first scanned image copies, generating second scanned image copies, and causing the print module to print the first copies on the first sheet and to print the second copies of the scanned image on the second sheet. For at least this reason, Claim 6 is patentable over the cited references as are Claims 7, 9, and 20-29 which depend from Claim 6.

CONCLUSION: The foregoing is believed to be a complete response to the outstanding Office Action. Claims 1, 3-7, 9, and 12-29 are in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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